

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Office Action of February 21, 2007. Applicant submits concurrently herewith an information disclosure statement and related 1449 including references responsive to the Request for Information Under 37 C.F.R. § 1.105 in the Office Action. Applicant has amended Claim 10 as set out above to correct a typographical error therein. Applicant respectfully submits that the pending claims are in compliance with sections 101 and 112 for at least the reasons discussed herein. Applicant has also amended independent Claims 1, 7, 10, 14 and 20 to further clarify that the cost estimate is associated with a single UPS in the backup power system. Furthermore, Applicant respectfully submits that the pending claims are patentable over the cited references for at least the reasons discussed herein.

The Request for Information Under 37 C.F.R. § 1.105

The Office Action requests "any known publications, brochures, manuals and press releases that describe" the three references provided in the Office Action. *See* Office Action, page 2. Applicant has filed an information disclosure statement including the requested documents concurrently herewith. Applicant respectfully submits that the information disclosure statement has been made with candor and good faith under 37 C.F.R. § 1.56.

The Section 101 Rejections

Claims 1-5 stand rejected under 35 U.S.C. § 101 "because the claimed invention is directed to non-statutory subject matter." *See* Office Action, page 4. In particular, the Office Actions states that Claims 1-5 do not recite a useful, concrete and tangible result. *See* Office Action, pages 4-6. Applicant respectfully submits that Claims 1-5 recite a useful, concrete and tangible result. For example, the recitations of estimating a cost savings attributable to use of a backup power system by obtaining historical power status information relating to operation of the backup power system and computing an estimate of cost savings from the obtained historical power status information as recited in Claim 1 are, at least, as tangible as determining a price of a share of stock, which was held to meet these requirements in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47

USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Furthermore, the claims fully comply with the New Guidelines set out by the USPTO on October 26, 2005.¹ Accordingly, Applicant respectfully maintains that Claims 1-5 recite statutory subject matter and respectfully request the rejections under section 101 be withdrawn for at least the reasons discussed herein.

The Section 112 Rejections

Claims 10 and 12-13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. *See* Office Action, page 6. The Office Action states:

...Claims 10 and 12-13 are drawn to any "data processor", regardless of construct, that performs the function recited...Thus, claims 10 and 12-13 yield a "data processor" that achieves a result without defining what will do so.

See Office Action, page 7. Applicant respectfully disagrees. Claim 10 recites:

A calculator for estimating a cost savings attributable to use of a backup power system, comprising **a data processor configured to obtain historical power status information relating to operation of a UPS in the backup power system and compute an estimate of cost savings for the UPS from the obtained historical power status information.**

Thus, the data processor recited in Claim 10 is not a generic data processor as suggested in the Office Action, it is a data processor configured to perform functions in accordance with embodiments of the present invention. Applicant respectfully submits that the recitations of Claims 10 and 12-13 comply with the enablement requirement of section 112 for at least the reasons discussed herein.

The Section 103 Rejections

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication No. 2003/032949 to Fallon (hereinafter "Fallon") in view of United States Patent No. 6,411,910 to Eulau (hereinafter "Eulau"). *See* Office Action, page 7. Applicant respectfully submits that many of the recitations of Claim 1 are neither

¹ See http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

disclosed nor suggested by the cited combination for at least the reasons discussed herein.

For example, Claim 1 recites:

A method of estimating a cost savings attributable to use of a UPS in a backup power system, the method comprising the following steps implemented in a data processing system:
obtaining historical power status information relating to operation of the UPS in the backup power system; and
computing an estimate of cost savings for the UPS from the obtained historical power status information.

Independent Claims 10 and 14 contain corresponding calculator and computer program product recitations, respectively. Applicant respectfully submits that at least the highlighted recitations of Claim 1 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Office Action states that Fallon teaches all the recitations of Claim 1 except "computing an estimate of cost savings from the obtained historical power status information." *See* Office Action, page 8. However, the Office Action points to Eulau as providing the missing teachings. *See* Office Action, page 8. Applicant respectfully submits that the combination of Fallon and Eulau does not disclose or suggest the recitations of Claim 1 and that there is no motivation to combine Fallon and Eulau as suggested in the Office Action for at least the reasons discussed herein.

Fallon discusses a user interface providing UPS information as recited in the title. As discussed in Fallon:

[0108] In at least some embodiments of the invention, parts of the software application 70 can track information about the events that occur, to provide further information to a user and/or to the manufacturer(s) of the UPS 50 and/or the software application 70. For example, in at least one embodiment of the invention, the event notifier 130 also provides information for an event log. The worker module 100 maintains a log of all events generated by the UPS 50 as well some events associated with the software application. The event log includes the date, time and description of the event.

[0109] The events that are logged are used to generate information and reports about the performance of the UPS 50 and can be used for other aspects of the software application 70. Representative examples of events that can be logged include blackout, undervoltage, overvoltage, sensitivity fluctuation, self-test with result, worksafe condition, shutdown, hibernation, and online (the latter can be used to determine how long the UPS 50 was on battery due to a power event).

FIG. 10 is an illustrative representative screen shot illustrating a performance summary report 400 based on events that the software application 70 logged over a time period., which may include information such as when the battery backup last intervened, the period of time the battery backup was in use, how many times battery backup power has been used and the like.

See Fallon, Figure 10 and paragraphs 108 and 109 (emphasis added). In other words, Fallon discusses tracking information associated with a UPS and generating reports including the tracked information. Figure 10 of Fallon illustrates an exemplary report generated using the systems/methods of Fallon. The teachings of Fallon are limited to providing information with respect to one or more UPSs in a user friendly manner. Nothing in Fallon discloses or suggests using the obtained information relating to operation of a UPS to compute an estimate of cost savings for a particular UPS as recited in Claim 1 of the present application.

Eulau does not provide the missing teachings. In particular, Eulau discusses a system and method for estimating power availability as stated in the title. As discussed in Eulau, an estimate is generated to determine the probability that power **will be available for a particular building**. See Eulau, column 4, lines 2-5. As illustrated in, for example, Figures 10 and 19 and the corresponding text of Eulau, "cost information" and "revenue and profit impact" information may be provided in the reports generated by the system and method of Eulau. However, the reports, for example, the revenue and profit risk report (Figure 19), of Eulau are generated based on information such as number of employees, average cost of employees, percent of employee time wasted when the system is unavailable, revenue generated per year, and the like. See Eulau, Figure 13. Furthermore, the cost information is for a whole building on a very large scale. In stark contrast, Claim 1 recites computing an estimate of cost savings for a single UPS from obtained historical power status information. In other words, embodiments of the present invention provide information as to whether a particular UPS is saving money for the company. Nothing in Eulau discloses or suggests generating the reports based on **historical data** associated with a UPS in the backup power system as recited in Claim 1.

Accordingly, Applicant respectfully submits that the cited combination does not disclose or suggest computing an estimate of cost savings **for the UPS from the obtained historical power status information** as recited in Claim 1 for at least the reasons discussed herein. Furthermore, Applicant respectfully submits that the Office Action does not provide

an adequate motivation to combine the cited references as suggested in the Office Action. Applicant would like to point out that to establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and **there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify the reference or to combine reference teachings**. M.P.E.P. §2143 (emphasis added). **A patent composed of several elements is not proven obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007) (emphasis added). One of the ways in which a patent's subject matter can be proven obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims. *Id.* at 16. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. *Id.* at 17.

The Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art to use the historical data obtained from Fallon with the cost savings as taught by Eulau, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

See Office Action, page 8. Applicant respectfully submits that the motivation provided in the Office Action is not adequate to sustain the Office's burden under section 103. As discussed above, a patent composed of several elements is not proven obvious merely by demonstrating that each of its elements was, independently, known in the prior art. In other words, the Office cannot just use Applicant's disclosure to locate the individual recitations of the claims in multiple references and then conclude that it would have been obvious to combine the references to teach the claims as a whole. If this were allowed, then every claim would be rendered obvious. The motivation must be present in the references or in the art without using Applicant's disclosure as a road map. If the motivation provided in the Office Action were adequate to sustain the Office's burden, then anything that "is an excellent means to

justify the purchase and maintenance of a backup power supply" would render a combination obvious. This cannot be the case.

Furthermore, even if combined, the combination does not disclose or suggest computing an estimate of cost savings from the obtained historical power status information as recited in Claim 1. The combination of Fallon and Eulau teaches a system for collecting information related to the operation of a UPS and presenting the information in a user friendly manner and generating a revenue and profit risk report (Figure 19 of Eulau) associated with predicted power failures for an entire building based on information such as number of employees, average cost of employees, percent of employee time wasted when the system is unavailable, revenue generated per year, and the like. Nothing in the cited combination discloses or suggests provision of a cost estimate for a particular UPS as recited in Claim 1 of the present application.

Accordingly, Applicant respectfully submits that Claims 1, 10 and 14 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections with respect to these claims.

Independent Claim 7 recites:

A method of estimating cost savings attributable to use of a UPS in a backup power system, the method comprising the following steps implemented on a data processing system:

- receiving historical power status information from the UPS over a communications link;
- accepting a power outage cost factor from a user interface;
- computing an estimate of cost savings for the UPS based on the historical power status information and the power outage cost factor; and
- displaying the estimate of cost savings for the UPS on the user interface.

Independent Claim 20 contains corresponding computer program product recitations.

Applicant respectfully submits that at least the highlighted recitations of Claim 7 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

In particular, the Office Action states that Fallon teaches all the recitations of Claim 7 except "accepting a power outage cost factor from a user interface and computing an estimate of cost savings based on the historical power status information and the power outage cost factor." See Office Action, page 11. However, the Office Action points to Eulau as

providing the missing teachings. *See* Office Action, page 11. Applicant respectfully submits that the combination of Fallon and Eulau does not disclose or suggest the recitations of Claim 7 and that there is no motivation to combine Fallon and Eulau as suggested in the Office Action for at least the reasons discussed above with respect to Claim 1.

Accordingly, Applicant respectfully submits that Claims 7 and 20 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections with respect to these claims.

Many of the Dependent Claims are Separately Patentable over the cited combination

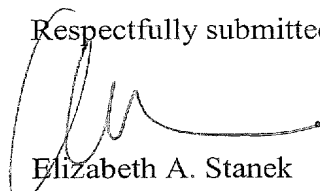
As discussed above, the dependent claims are patentable over the cited references at least per the patentability of the independent base claims from which they depend. However, many of the dependent claims are also separately patentable over the cited combination.

For example, dependent Claims 4, 9, 13, 17 and 22 recite the details of computing an estimate of cost savings for a UPS based on obtained historical power status information. As discussed above, nothing in the cited combination discloses or suggests computing a cost estimate based on historical data. Thus, it follows that nothing in the cited references disclose or suggest the details thereof. Accordingly, Applicant respectfully submits that dependent Claims 4, 9, 13, 17 and 22 are patentable over the cited references for at least these additional reasons.

CONCLUSION

In light of the above discussion, Applicant submits that the present application is in condition for allowance, which action is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



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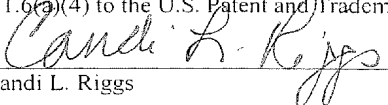
In re: Marcus A. Maxwell
Serial No.: 10/701,850
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